

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/802,141

**Applicant(s)**

SONT ET AL.

**Examiner**

CHRISTOPHER KESSLER

**Art Unit**

1793

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 05 August 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 19-20, 22-32, 35, 37-39, and 41-47.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Roy King/  
Supervisory Patent Examiner, Art Unit 1793

/C. K./  
Examiner, Art Unit 1793

Continuation of 11, does NOT place the application in condition for allowance because: Applicant makes no amendments to the claims. Applicant argues that the reference Ladousse teaches away from the instant invention in that the reference does not teach substantially finishing the workpiece as is claimed in instant claims 19 and 35. This argument is not persuasive. While Ladousse teaches that an additional sizing step 88 is included, Ladousse explicitly states that this step is optional (see col. 11, as cited in the Office Action of 5 June 2008). Further, Ladousse appears to teach that this step takes place while the blank is engaged in the tools for rolling (see cols. 11-2, as cited in the Office Action of 5 June 2008). Thus Ladousse teaches a geometric finishing of the part takes place. The examiner notes that the claims are directed to "rolling the workpiece to a substantially finished outer profile shape." The roundness criterion taught by Ladousse quite clearly meets these limitations. Ladousse is further applied to the claims as stated in the rejection of 5 June 2008.

Applicant states that Amateau or Sonti are not the closest prior art, but rather a conventional powder metal gear making method is the closest prior art. The examiner disagrees with this position. The examiner maintains that the method of Nagesh and/or Sonti is the closest prior art because it teaches asforming as claimed. Where the comparison is not identical with the reference disclosure, deviations therefrom should be explained. In re Finley, 174 F.2d 130, 81 USPQ 383 (CCPA 1949), and if not explained should be noted and evaluated, and if significant, explanation should be required. In re Armstrong, 280 F.2d 132, 126 USPQ 281 (CCPA 1960) (deviations from example were inconsequential). Applicant has still not explained the nature of the differences in the prior art compared in the 132 declarations and the prior art cited in the instant application. Applicant's goal for manufacturing a superior powder metal gear does not explain the differences between the cited prior art and the prior art compared in the 132 declarations. The examiner notes that applicant should not have to compare data from the instant gear making process to another asformed powdered metal gear making process. Rather, to overcome the rejection using a 132 declaration, applicant should compare the invention only to the closest prior art (Amateau and/or Sonti).

Applicant argues that the design of the dies used in the process represents a significant engineering challenge. While the Examiner does not disagree with this assertion, the claims are rejected as stated in the prior Office Action.

Applicant argues that no plastic deformation is performed in Ladousse. However, Ladousse clearly teaches that a geometric finishing step takes place in rolling dies (see cols. 11-2, as cited in the Office Action of 5 June 2008). Thus, plastic deformation does occur.

Applicant argues that the 132 declarations show an unexpected improvement over conventional wrought gears. Applicant argues that the same unexpected results over the wrought asformed gears of Amateau would be "readily apparent to one skilled in the art." Any evidence of unexpected results should be submitted in the form of a declaration under 37 CFR 1.132. If applicant wishes to submit evidence of unexpected results over the wrought asformed gear making process of Amateau and/or Sonti, the Examiner will consider said evidence if it is in the form of a properly executed 132 declaration.

Applicant states that the methods of Ladousse necessitate subsequent heat treatment and grinding processes. however, these are not detailed by Ladousse. Ladousse teaches that the gear is subjected to a "final sizing phase" using rolling dies (see cols. 11-2, as cited in the Office Action of 5 June 2008).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Kessler whose telephone number is (571) 272-6510. The examiner can normally be reached on Mon-Fri, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.